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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,721	01/27/2000	James W. Cree	31358-233	8978
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FISH & RICHARDSON P.C. 5000 BANK ONE CENTER 1717 MAIN STREET DALLAS, TX 75201				
			EXAMINER PIERCE, JEREMY R	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/491,721

**Applicant(s)**

CREE ET AL.

**Examiner**

Jeremy R. Pierce

**Art Unit**

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 8, 2003 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed on September 8, 2003 has been entered. Claim 25 has been amended. Claims 1-17 and 25-29 are currently pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

Art Unit: 1771

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 25 recites the first nonwoven web to be "substantially permanently set in a transversely consolidated state before being bonded to the elastic polymeric film."

Similar recitation is made in regards to the second nonwoven web. There is no support for "setting" the web in the specification.

Claim 25 recites "the tear-resistant laminate has not been further substantially consolidated after assembly." Support for this limitation is not found in the specification. Negative limitations are not allowed in the claims unless specifically set forth in the specification. *Ex parte Grasselli*, 231 USPQ 393.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the first nonwoven web to be "substantially permanently set in a transversely consolidated state before being bonded to the elastic polymeric film."

Similar recitation is made in regards to the second nonwoven web. What does it mean to be "substantially permanently set?" At what point is the material "set" enough to qualify as being substantially permanently set? If a nonwoven fabric were "set," that would seem to indicate that the fibers of the fabric are bonded to one another

sufficiently to retain a fabric form. Applicant does not concisely define "set" in the specification to mean anything more.

***Claim Rejections - 35 USC § 102/103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-6, 9-11, 13-17, and 25-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morman (U.S. Patent No. 5,336,545).

Morman teaches a composite elastic neck-bonded material comprising a necked fabric bonded to an elastic sheet (column 3, lines 19-24). The elastic sheet may be a film (column 3, lines 6-7) and can have two necked fabrics bonded on both sides of it (column 3, lines 31-35). Morman uses similar materials as the Applicant, such as polypropylene for the necked nonwoven fabric (column 25, lines 41-45) and block copolymers for the elastic sheet (column 6, lines 55-56). Although Morman does not explicitly teach the limitations ultimate force to break values of the nonwoven fabrics and the composite in grams per inch, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polypropylene for the nonwoven and block copolymer films for the elastic sheet) and in the similar production steps (i.e. necking the nonwoven prior to lamination) used to produce the elastic composite material. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been

Art Unit: 1771

obvious to a person having ordinary skill in the art to provide the claimed ultimate force to break properties in order to provide a composite with an increased resistance to breaking, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. With regard to claim 3, having between 2 and 50% of the thermoplastic fibers skewed in a direction greater than about 10 degrees from the machine direction is an inherent feature to the nonwoven web of Morman since the webs are meltblown, which involves random deposition of the fibers. With regard to claim 4, Morman teach the nonwoven web is made from microfibers with an average diameter of from about 4 to 40 microns (column 2, lines 32-37). It is known that 15-micron polypropylene is equal to 1.42-denier polypropylene; thus, Applicant's claimed range for fiber mass per unit area is clearly anticipated. With regard to claim 5, meltblown fibers are randomly deposited (column 2, lines 38-50). With regard to claim 6, Morman discloses the fabric can weigh between 0.2 and 10 ounces per square yard (column 6, lines 5-21). With regard to claim 10, Morman discloses the preferred use of low weight elastic sheets for economic reasons, but also discloses the use of sheets with a basis weight of up to 10 ounces per square yard (column 9, lines 1-7). With regard to claims 13 and 29, although Morman does not explicitly teach the limitation of Dart Impact value for the elastic sheet, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar

Art Unit: 1771

materials (i.e. block copolymer) and in the similar production steps (i.e. similar weights) used to produce the elastic sheet. The burden is upon the Applicant to prove otherwise. In the alternative, it would have been obvious to one having ordinary skill in the art to provide a polymeric film layer with a Dart Impact value of at least 400 grams in order to create a film that is puncture and resistant, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. With regard to claims 15-17, Morman discloses the nonwoven fabrics and elastic sheet can comprise multiple layers (column 3, lines 19-46). With regard to claim 25, the nonwoven fabrics are set because meltblown fabrics have fibers that are bonded sufficiently to form a fabric. Alternatively, the recitation that the nonwoven web is set before being bonded to the film is the recitation of a processing step that would not create a materially different product. When the nonwoven fabrics of Morman are bonded to the film, heat is applied (column 8, line 56). The fibers would remain in a transversely consolidated state, thereafter, and the final product would be substantially similar to the claimed product.

***Claim Rejections - 35 USC § 103***

9. Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morman in view of Hassenboehler et al. (U.S. Patent No. Re 35,206).

Applicant argues that Morman does not disclose the nonwoven webs to be substantially permanently set in a transversely consolidated state. The Examiner disagrees, as set forth above in section 8, because the limitation that the web is "set" is

indefinite and not clearly defined in the specification. Alternatively, Hassenboehler et al. teach transversely consolidating a nonwoven web (Abstract). Hassenboehler et al. teach that the nonwoven materials exhibit remarkable elasticity in the cross-direction (column 8, lines 30-34). It would have been obvious to a person having ordinary skill in the art at the time of the invention to transversely consolidate the web of Morman in order to provide increased elasticity in the cross-direction, as taught by Hassenboehler et al.

10. Claims 7, 8, and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Morman in view of Haffner et al. (U.S. Patent No. 5,789,065).

Morman do not teach the elastic sheet to be made from metallocene-based low-density polyethylene film. Haffner et al. disclose block copolymers and metallocene-catalyzed ethylene films as suitable elastic film layers useful in the same art of personal care products. It would have been obvious to one having ordinary skill in the art to use a metallocene-catalyzed ethylene film in the composite of Morman, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. With regard to claim 12, Morman does not teach perforating the elastic sheet. However, Haffner et al. disclose providing perforations in the elastic film layer allow it to be breathable. It would have been obvious to one having ordinary skill in the art to provide perforations in the elastic sheet of Morman in order to provide breathability to the composite, as taught by Haffner et al.



***Response to Arguments***

11. Applicant's arguments filed September 8, 2003 have been fully considered but they are not persuasive.

12. Applicant argues that the burden of proof has not shifted to the Applicant to show the product of Morman does not meet the claimed property limitations. However, the Examiner has set forth a reasonable basis for the properties to be inherent, so the burden has shifted to Applicant to prove otherwise.

13. Applicant specifically argues that Morman fails to teach a nonwoven web that has been substantially permanently set in a transversely consolidated state before being bonded to the elastic polymer film. However, the Applicant has not set forth in the specification what it means for a nonwoven web to be substantially permanently set in a transversely consolidated state. This limitation is indefinite. Additionally, the limitation is a processing step, but claims are directed to a product. Applicant has not shown that performing the processing limitation would produce a materially different product than that of the prior art laminate of Morman.

14. Applicant argues that it would not be obvious to modify Morman to meet the limitations of claim 25 because Morman teaches away from the "setting" limitation by using a roller speed to tension the web while bonding. However, even if the web of Morman were pre-consolidated as taught by Hassenboehler et al., this would not preclude using a roller that applies the web in a tensioned fashion. It is also not necessary to apply the web in a tensioned state twice. A person of ordinary skill in the art would substitute the tensioning of Hassenboehler et al. for the tensioning step of

Art Unit: 1771

Morman, rather than adding a second tensioning step to the process of creating a laminate web.

15. Applicant argues that the Examiner cannot make a prima facie case that the prior art laminate has an ultimate force to break of at least 3000 g/in. because it is not made the same way as Applicant's laminate. However, the Examiner has set forth a reasonable basis for the prior art laminate to be substantially similar to the claimed laminate. The burden has shifted to the Applicant to prove otherwise.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1771

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

*sep*

JRP

October 26, 2004

*Elizabeth M. Cole*  
ELIZABETH M. COLE  
PRIMARY EXAMINER